

REMARKS

Reconsideration of the application identified in caption in light of the remarks which follow is respectfully requested.

In the Official Action, claims 1-6 stand rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 6,361,768 (*Galleguillos et al*). Withdrawal of this rejection is respectfully requested for at least the following reasons.

Independent claim 1 is directed to an ink jet recording medium comprising at least one ink receptive layer containing polymeric organic particles provided on a support, wherein the polymeric organic particles have a glass transition temperature (T_g) of 40°C or higher and an average particle diameter of 1 to 500 nm, and are amphoteric polymeric organic particles having a cationic group and an anionic group.

Galleguillos et al relates to a hydrophilic, ampholytic polymer (col. 1, lines 4-5). *Galleguillos et al* discloses that such hydrophilic polymers readily associate with, have an affinity for, and dissolve in water (col. 1, lines 5-6).

Galleguillos et al does not disclose each feature recited in independent claim 1, and as such fails to constitute an anticipation of such claim. For example, *Galleguillos et al* does not disclose at least one ink receptive layer containing polymeric organic particles which have an average particle diameter of 1 to 500 nm, as recited in claim 1. In stark contrast, *Galleguillos et al* discloses a copolymer in the form of a fine powder with submicron particle size that is readily dissolved in water (col. 3, lines 56-58; abstract). This copolymer fine powder cannot properly be considered the same as the recited polymeric organic particles which have an average particle diameter of 1 to 500 nm.

In this regard, the Examiner has taken the following position at pages 2-3 of the
Official Action:

Even though the prior art teaches that the copolymer dissolves readily in water, the prior art does not expressly disclose that the copolymer dissolves completely. The copolymer may partially dissolve and may comprise reduced particle diameter.

However, the Patent Office has not satisfied its burden of proof for properly alleging an inherent disclosure. "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (emphasis added). "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent feature necessarily flows from the teachings of the applied prior art." *Ex Parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Here, the Examiner has asserted that the dissolved copolymer "may partially dissolve and may comprise reduced particle diameter" (emphasis added). The Examiner has merely alleged the possibility that the dissolved copolymer of *Galleguillos et al* may exhibit the claimed characteristics. As discussed above, however, the mere fact that a certain thing may result from a given set of circumstances is not sufficient to establish inherency. In the present case, the Patent Office has failed to provide any evidence or scientific reasoning which establishes with the requisite certainty that (1) the copolymer fine powder is partially dissolved, and (2) such alleged partially dissolved particles have a particle diameter within the claimed range. Inherency cannot be based on mere possibilities or conjecture. But that is

precisely what the Examiner has relied on in the present case. Simply put, the Patent Office has not met its burden of proof of establishing inherency with the requisite certainty.

In light of the above, *Galleguillos et al* does not constitute an anticipation of the recited ink receptive layer containing polymeric organic particles which have an average particle diameter of 1 to 500 nm. Accordingly, withdrawal of the above rejection under 35 U.S.C. §102 is respectfully requested.

With regard to the experimental results set forth in the Declaration Under 37 C.F.R. §1.132 filed November 1, 2006 (hereinafter "Declaration"), the Examiner has taken the following position at page 3 of the Official Action:

. . . it is impossible to determine that excellent color density has been obtained by using the claimed particle diameter because the value of excellent or acceptable color density has never been defined either in the specification or in the declaration.

However, the Declaration itself provides experimental data comparing the color density characteristics obtained by employing exemplary ink jet recording mediums according to the claimed invention, with those obtained in comparative examples. It is this comparison between the exemplary inventive recording mediums and the comparative examples which show that aspects of the claimed invention can provide surprising and unexpected results in the form of improved color density characteristics. As would plainly be apparent to one skilled in the art, the experimental results obtained in connection with the inventive examples are "excellent" insofar as they provide an improvement over the comparative examples. In this regard, the Examiner's attention is directed to the experimental data set forth at Tables I and II of the Declaration. Thus, in view of such experimental data, withdrawal of the above rejection is in order and such action is respectfully requested.

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited.


If there are any questions concerning this paper or the application in general, the Examiner is invited to telephone the undersigned.

Respectfully submitted,

BUCHANAN INGERSOLL & ROONEY PC

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By:



Roger H. Lee
Registration No. 46317

P.O. Box 1404
Alexandria, VA 22313-1404
703.836.6620